No. 18,687

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

NU-MATIC NAILER INTERNATIONAL CORP.,

Appellant,

vs.

CLYDE WEEMS,

Appellee.

PETITION FOR REHEARING.

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To the Honorable Chambers, Circuit Judge, Koelsch, Circuit Judge, and Jameson, District Judge:

This Court has requested the District Court to vacate its findings and judgment and enter new ones—and to distinguish accused device No. 1 from accused device No. 2 in such proposed findings. In making this request, this Court has stated as its reason that "the essence of the supplemental complaint is that accused device No. 2 is so similar to accused device No. 1 that the first judgment covers it".

The supplemental complaint in its prayer for relief, merely requests that defendant be enjoined from infringing United States Letters Patent No. 2,546,354. The supplemental complaint is in accord with the contempt hearing in which the Judge concluded that he would not decide whether accused device No. 2 corresponded to accused device No. 1 *relative to infringe-*

ment of the patent. In other words, the result of the contempt hearing was that accused device No. 2 differed from accused device No. 1 to such an extent that a separate trial was required with respect to the infringement issue of accused device No. 2.

After a lengthy and prolonged trial as well as several post-trial hearings, the second trial Judge concluded that accused device No. 2 did not infringe the patent.

The findings as proposed by this Court would be of evanescent value, for the test of infringement is but the test of trespass upon the claimed property defined by word boundaries. If accused device No. 2 were materially distinguished from accused device No. 1 in mechanical structure and operation, it might fall on the black side of the gray area of the claimed property and yet still infringe if it overlapped the boundaries of same—even though accused device No. 1 fell on the white side. Contrawise, accused device No. 2 might be very close in structure and operation to accused device No. 1 and not infringe even though it also fell on the white side of the gray area of the claimed patent property. Thus, the task of meaningfully comparing different devices is a difficult and elusive problem not appropriately susceptible of succinct findings suggested by this Court, particularly when the issue tried was only that of infringement.

Moreover, the only conceivable purpose in having findings distinguishing accused device No. 2 from accused device No. 1 would be to show that such machines were different such that the affirmative defense of *res judicata* would be inapplicable. However, (as hereinbefore stated) plaintiff did not pray for relief

on the basis of the doctrine of *res judicata* and did not direct its evidence towards such a contention.

To require the District Court to set forth findings supporting the inapplicability of such doctrine is analogous to stating that the District Court has a duty to state in its findings why any possible affirmative defense (as provided in Federal Rules of Civil Procedure 8 (c)), for example, does not apply. Such a ruling is beyond the scope of Rule 52, FRCP, and particularly so in the present case wherein the contempt hearing, in effect, found the doctrine of *res judicata* inapplicable and the ultimate issue of infringement necessary to be tried.

In view of the foregoing, a rehearing in this matter is respectfully requested.

Elliott & Pastoriza,
By William J. Elliott,
Attorneys for Clyde Weems, Appellee.

Certificate of Counsel.

I, William J. Elliott, counsel for Petitioner in the above entitled action, hereby certify that the foregoing petition for rehearing of this cause is presented in good faith and not for delay, and in my opinion is well founded in law and in fact, and proper to be filed herein.

WILLIAM J. ELLIOTT